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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

YOR920010386US2

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on March 15, 2006

Signature _____

Typed or printed name Tina Maurice

Application Number

09/938,147

Filed

August 22, 2001

First Named Inventor

Janniello et al.

Art Unit

2153

Examiner

Sean M. Reilly

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record. 36,597
Registration number _____☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Kevin M. Mason
Signature

Kevin M. Mason
Typed or printed name

203-255-6560
Telephone number

March 15, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s) Janniello et al.
Docket No.: YOR920010386US2
Serial No.: 09/938,147
Filing Date: August 22, 2001
Group: 2153
Examiner: Sean M. Reilly

I hereby certify that this paper is being deposited on this date with the U.S. Postal Service as first class mail addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Signature: *Gene Manna* Date: March 15, 2006

Title: Apparatus, System and Method for Distributing Internet Content
Via Broadcast Channels in a Peer-to-Peer Environment

TRANSMITTAL LETTER

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is the following document relating to the above-identified patent application:

- (1) Notice of Appeal;
- (2) Pre-Appeal Brief Request for Review;
- (3) Memorandum in Support of Pre-Appeal Brief Request for Review; and
- (4) Petition for Extension of Time.

There is an additional fee of \$500.00 due in conjunction with this submission under 37 CFR §1.17(b). Please charge **IBM Corporation's Deposit Account No. 50-0510** the amount of \$500.00 to cover the submission under CFR §1.17(b). In the event of non-payment or improper payment of a required fee, the Commissioner is authorized to charge or to credit **Deposit Account No. 50-0510** as required to correct the error. A duplicate copy of this letter and a duplicate copy of the Notice of Appeal are enclosed.

Respectfully submitted,

Kevin M. Mason

Dated: March 15, 2006

Kevin M. Mason
Attorney for Applicant(s)
Reg. No. 36,597
Ryan, Mason & Lewis, LLP
1300 Post Road, Suite 205
Fairfield, CT 06824
(203) 255-6560



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

5 Applicant(s): Janniello et al.
Docket No.: YOR920010386US2
Serial No.: 09/938,147
Filing Date: August 22, 2001
Group: 2153
10 Examiner: Sean M. Reilly

I hereby certify that this paper is being deposited on this date with the U.S. Postal Service as first class mail addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signature: John Mauria Date: March 15, 2006

Title: Method and Apparatus for Client Sharing of Cached Content

15 MEMORANDUM IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW

20 Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

25 Sir:

The present invention and prior art have been summarized in Applicants' prior responses.

STATEMENT OF GROUNDS OF REJECTION

30 Claims 21-23 remain rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Claims 1-13 and 15-27 remain rejected under 35 U.S.C. §103(a) as being unpatentable over Carter et al. (United States Patent Number 6,026,474) and Humphrey (United States Patent Application Publication Number 2002/0129116), and claims 1-13 and 15-28 remain rejected under 35 U.S.C.
35 §103(a) as being unpatentable over Carter et al. and Mao et al. (United States Patent Number 6,886,178).

ARGUMENTS

Section 101 Rejections

40 Claims 21-23 were rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. In the Response to Arguments

section of the final Office Action, the Examiner asserts that a computer readable medium as defined by Applicant on page 12 of the specification may be a recordable medium or a transmission medium and, as previously indicated, a transmission medium is not a tangible medium. In the Advisory Action, the Examiner referred Applicants to pages 50-57 of the recently published "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility."

Applicants note that the term "tangible" means "having substance or material existence." (See, dictionary.com.) Contrary to the Examiner's assertion, a *transmission medium is a tangible entity, consisting of radio waves, light waves, electronic signals, etc.* Claims 21-23 require a *computer readable medium having computer readable code means embodied thereon*, and are therefore limited to *tangible* embodiments.

Regarding the Examiner's reference to the published guidelines, Applicants note that the cited guidelines teach that,

from a technological standpoint, *a signal encoded with functional descriptive material is similar to a computer-readable memory encoded with functional descriptive material, in that they both create a functional interrelationship with a computer.* In other words, a computer is able to execute the encoded functions, regardless of whether the format is a disk or a signal.
(Second to last paragraph on page 57; emphasis added.)

Regarding a computer-readable memory encoded with functional descriptive material, the published guidelines teaches that,

when functional descriptive material is recorded on some computer-readable medium *it becomes structurally and functionally interrelated to the medium and will be statutory in most cases* since use of technology permits the function of the descriptive material to be realized.
(Page 50, second paragraph; emphasis added.)

As noted above, claims 21-23 require a *computer readable medium having computer readable code means embodied thereon*. Applicants note that computer readable code means is classified as functional descriptive material and that claims 21-23 are therefore directed to statutory subject matter. Claims 21-23 are therefore directed to statutory subject matter and Applicants respectfully request that the section 101 rejections be withdrawn.

Independent Claims 1, 9, 15, 18-23 and 28

Independent claims 1, 9, 15, 18-23, and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Carter et al. and Humphrey and independent claims 1, 9, 15, 18-23, and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Carter et al. and Mao et al. Regarding claim 1, the Examiner asserts that Carter discloses receiving content broadcast to a client (col. 27, lines 65-66) and storing said received content in said client-side cache (col. 28, lines 7-10). In the Response to Arguments section of the final Office Action, the Examiner asserts that Carter clearly discloses storing content based on a user profile (Carter's system utilizes a migration controller that manages the storage of content based on, among other items, user data access patterns (col. 14, lines 40-46)). The Examiner further asserts that Mao also stores content based on a user profile (Mao only stores the most recently accessed web pages (col. 8, lines 61-65, and col. 9, lines 3-7)). In the Advisory Action, the Examiner asserts that a "user profile" is merely any data set that represents characteristics of users and maintains that the data access patterns taught by Carter are analogous to Applicant's claimed user profile.

Applicants note that the present specification, as amended, teaches that, "for example, the user profile 260 might provide a list of the users most popular sites." (Page 6, line 10, of the amended specification; emphasis added.) User profile 260 is a data entity (see, FIGS. 2 and 3). Regarding the Examiner's assertion that the data access patterns taught by Carter are analogous to Applicant's claimed user profile, Applicants note that this definition is contrary to the well known definition of a user profile. For example, Lalmas et al. in a report entitled "Personalised Enriched Broadcast Experience" teach that *"users profiles were represented as a list of likes and dislikes with associated probability values reflecting the degree of interest."*

(See, http://www.ercim.org/publication/Ercim_News/enw62/lalmas.html.) Carter does not disclose or suggest that the data access patterns are lists, or that the access patterns indicate a degree of interest of a user. In addition, Carter does not disclose or suggest that the data access patterns indicate the access pattern(s) of a single user and, thus, cannot provide a profile of a **user**.

Neither Carter, Humphrey, nor Mao, however, address the issue of storing content *based on a user profile*, as defined in the present disclosure. Humphrey, for example, is directed to broadcasting information, for example, “when the rate of requests for information exceeds a predetermined number over a predetermined time.” (Paragraph 52) Carter is directed to a shared client-side Web cache, wherein the Web cache is shared by a particular group of users. (Col. 2, lines 38-40.) In the text cited by the Examiner, Carter teaches that “the migration controller can determine and respond to data access patterns, resource demands or any other criteria or heuristic suitable for practice with the invention. Accordingly, the migration controller can balance the loads on the network, and move data to nodes from which it is commonly accessed.” (Col. 14, lines 40-46.) Mao is directed to formatting Internet HTML Web page data to fit within a standard MPEG-2 data packet structure, and multiplexing it along with other MPEG-2 digital video signals for transport within a multiple channel digital video system (see, Abstract). In the text cited by the Examiner, Mao teaches that “between the two extremes of no storage at one end, and 100% local storage of the rotating carousel at the other end, there is a variety of partial storage options. One option is to use a high-speed cache to store a number of the most recently accessed Web pages.” (Col. 8, lines 61-65.) Neither the data access patterns taught by Carter nor the most recently accessed Web pages taught by Mao are user profiles, as defined in the present specification and as understood by a person of ordinary skill in the art. Independent claims 1, 9, 15, 18-23, and 28 require *storing content based on a user profile*.

Thus, Carter et al., Humphrey, and Mao et al., alone or in combination, do not disclose or suggest storing content based on a user profile, as required by independent claims 1, 9, 15, 18-23, and 28.

Dependent Claims 25 and 27

Dependent claims 25 and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Carter et al. and Humphrey and under 35 U.S.C. §103(a) as being unpatentable over Carter et al. and Mao et al. Regarding claims 25 and 27, the Examiner acknowledges that Carter fails to specifically recite where received content was predicted to be of interest to a user, but asserts that Humphrey discloses predicting content of interest to a user (page 2, paragraph 24), and then sending the content

predicted to be of interest prior to a client request (page 2, paragraph 25). The Examiner further asserts that Mao discloses that said "broadcast content to said client...was predicted to be of interest to a user." (Col. 4, lines 6-9.)

Applicants note that, in the text cited by the Examiner, Humphrey teaches to "determine what information is of *global interest to the Internet community*." (Page 2, paragraph 24; emphasis added.) Applicants also note that, in the text cited by the Examiner, Mao teaches that "typical broadcast Web sites contain news, weather and sports, but can be any Web site of general interest to many viewers." (Col. 4, lines 6-9.) Neither Humphrey nor Mao discloses or suggests to determine what information is *predicted to be of interest to a user*. In addition, Applicants could find no disclosure or suggestion in either Carter, Humphrey, or Mao to combine the determination of what information is of interest to the Internet community, with the invention of Carter.


Thus, Carter et al., Humphrey, and Mao, alone or in combination, do not disclose or suggest wherein said received content was predicted to be of interest to a user, as required by claims 25 and 27.

Conclusion

The rejections of the cited claims under 35 U.S.C. §103(a) as being unpatentable over Carter et al. and Humphrey, and under 35 U.S.C. §103(a) as being unpatentable over Carter et al. and Mao et al. are therefore believed to be improper and should be withdrawn. The remaining rejected dependent claims are believed allowable for at least the reasons identified above with respect to the independent claims.

The attention of the Examiner and the Appeal Board to this matter is appreciated.

Respectfully,



Kevin M. Mason
Attorney for Applicant(s)
Reg. No. 36,597
Ryan, Mason & Lewis, LLP
1300 Post Road, Suite 205
Fairfield, CT 06824
(203) 255-6560

Date: March 15, 2006